REMARKS

The Office Action mailed August 24, 2005 considered and rejected claims 1-31 and 35.[1] By this paper claims 1, 11, 21, and 35 have been amended such that claims 1-31 and 35 remain pending, of which, claims 1, 11, 21, 23, 20, and 35 are the only independent claims at issue.

Claims 1 and 21 are method claims, which claim embodiments of applicants' invention from a client-side perspective, whereas claim 23 is directed to a similar method recited from the server-side perspective. Claims 11, 35, and 30 are computer program product claims which correspond to method claims 1, 21, and 23, respectively.

As presented herein for reconsideration, Applicants' claimed method and computer program product are adapted for use in a network environment that includes a client that is network connectable over a wireless network to a server so that the client may transmit document-inclusion operations that are intended to be carried out by the server, but wherein the wireless network may have limited throughput such that data transfer for document-inclusion operations may be unduly slow or costly. Applicants' claimed method and computer program product are designed to reduce those instances when the document-inclusion operation transmitted to the server actually requires transmission of the document that is required by the server to complete the requested operation, thereby reducing instances of unduly slow or costly data transmission when performing such document-inclusion operations over a wireless network.

As claimed for example in independent claim 1, the method includes sending from the client over the wireless network a document-inclusion instruction to the server, the instruction including an identification of the document that does not depend on whether the document is actually identifiable at the server or not, and wherein the document-inclusion instruction that is sent to the server does not include the document itself in the first instance. If the identified document is already stored at the server, the client's document-inclusion instruction is thus sufficient to permit the server to carry out the instruction so the client need take no further action in terms of sending the actual document to the server. On the other hand, if the identified document is not already stored at the server, then the client receives back from the server an

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[1] Claims 1-7, 11-18,21-29, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (U.S. 2002/0194307 A1) hereinafter '*Anderson*' in view of Oppenheimer et al (US 2003/0014477 A1) hereinafter '*Oppenheimer*'. Claims 8, 9, 10, 19, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson Anderson in view of Oppenheimer; and further in view of LaRue et al (U.S. 6,535,892 B1) hereinafter 'LaRue'. Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

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indication that the document identified in the document-inclusion instruction is unavailable to the server. The client may then determine whether to send the identified document to the server over the wireless network to allow the server to execute the document-inclusion instruction *using the document if sent by the client to the server* or whether to simply wait and send the document later over a network that does not have the kind of limited throughput and bandwidth that the wireless network has.

Independent claim 23 claims the method in similar terms, except from a server-side perspective of the method. Claim 21 is directed to applicants' method and claims it from a client-side perspective similar to claim 1, except that independent claim 21 includes a functional step as a limitation (e.g. "a step for ensuring that a document-inclusion operation corresponding to the document-inclusion instruction is performed by the client if and only if the client is advised by the server that the identified document is not already stored at the server, so as to conserve the network bandwidth of the wireless network and to allow the server to execute the document-inclusion instruction using the document if the document inclusion operation is performed by the client.").

As noted previously, claims 1, 11, 21, and 35 have been amended to further clarify what is recited by the claims. In particular, claims 1 and 11 now recite that "the client may then determine whether to send the identified document to the server and the client thereafter determining whether to send the document to the server and, whereupon if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server." Similarly, claims 21 and 35 recite "a step for ensuring that a document-inclusion operation corresponding to the document-inclusion instruction is performed by the client if and only if the client is advised by the server that the identified document is not already stored at the server so as to conserve the network bandwidth of the wireless network and, whereupon if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server." The server-side claims 23 and 30 also clearly recite corresponding limitations to those described above. In particular these claims recite how the server completes the document-inclusion instruction when the unavailable document is sent to the server by the client after the client determines whether to send the identified document to the server in response to the server sending an indication to the client that the document identified in the document-inclusion instruction is unavailable to the server.

This is in direct contrast to what is disclosed by *Anderson* and *Oppenheimer*. In particular, *Anderson* discloses a system where a mobile device can retrieve or print a document by causing a document to be attached to an e-mail. *Anderson* at [0036]-[0040]. For example, *Anderson* illustrates a request e-mail from a mobile device being sent to a document retriever where the email sends the document back to the mobile device [0038] and/or directly to a printer [0040]. As admitted by the Examiner in the present Office Action at page 3, *Anderson* fails to teach the element of "but if the identified document is not already stored at the server, then receiving from the server an indication that the document identified in the document-inclusion instruction is unavailable to the server so that the client may then determine whether to send the identified document to the server and the client thereafter determining whether to send the document to the server to allow the server to execute the document-inclusion instruction using the document if sent by the client to the server."

Applicants agree *Anderson* is deficient in this regard. In fact, *Anderson* only teaches receiving a request for a document that is known to be on the server. *Anderson* even goes so far as to include provisions to allow a user to request a directory of documents on the server when the path for the file is not known so that the user can specifically identify the documents that are known to be on the server. See *Anderson* at [0039]-[0040]. Thus, it is clear that *Anderson* teaches away from sending document-inclusion instructions to a server where it is unknown whether the document exists or, more particularly, "that does not depend on whether the document is actually identifiable at the server or not," as claimed.[2] Rather, *Anderson* requires, and provides provisions for, a retrieval message including "the directory location and file name of the document...." See *Anderson* at [0039]. As such, combining *Anderson* with a reference where a server does not include the document identified in a document-inclusion instruction is improper. See MPEP 2145 (X)(D)(2).

Applicants also submit that *Oppenheimer* fails to compensate for the deficiencies of *Anderson* in this regard. In fact, it is questionable whether *Oppenheimer* could even be combined with *Anderson* at all. In particular, *Oppenheimer* illustrates a method of storing a file on a server. *Oppenheimer* states that "[i]f a copy of the file already exists on the server, the file need not be uploaded from the user's local file system." *Oppenheimer* at [0045]. However, "[i]f

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[2] At the very most, Anderson merely indicates that if a document cannot be found the client is notified and the server thereafter waits for the next request email message. [0077]. There is clearly nothing that would teach or suggest that the client thereafter sends the document to the server for use in complying with the document-inclusion instruction, as claimed.

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an identical file is not already stored on [the server], the file is suitably uploaded ...." This, however, clearly does not teach or even suggest that the client thereafter determines whether to send the document to the server, and particularly, *whereupon, if it is determined by the client to send the document to the server, the server thereafter executes the document-inclusion instruction using the document sent by the client to the server.* Rather, *Oppenheimer* simply allows files to be stored for backup purposes or for remote file access. See *Oppenheimer* at [0045]. In fact, contrary to the assertions made in the office action, *Oppenheimer* does not include any teachings where document-inclusion instructions are provided or acted upon, let alone executing a document-inclusion instruction when the document is sent by the client to the server. Furthermore, as suggested above, *Oppenheimer* should not be combinable with *Anderson* to show sending a document-inclusion instruction to a server where the server does not already store the document inasmuch as Oppenheimer has nothing to do with document-inclusion instructions at all.

LaRue et al., U.S. Patent No. 6,535,892, which was cited only for showing determining version conflicts, also fails to compensate for the deficiencies of *Anderson* and *Oppenheimer* for at least failing to teach the limitations cited above.

Finally, Applicants respectfully traverse the Examiner's rejections of claims 23 and 30. In particular both claims 23 and 30 recite "the server thereafter completing the document-inclusion instruction only if the unavailable document is sent to the server by the client." As explained previously, *Anderson* only illustrates attaching a message when the message exists at the server. See *Anderson* at [0038]-[0039]. Thus, *Anderson* is silent about completing document-inclusion instructions when a message does not exist at the server. *Oppenheimer* does not compensate for the deficiencies of *Anderson* in this regard. Instead, *Oppenheimer* merely teaches that documents can be uploaded to a server for *storage* if they do not already exist on the server. *Oppenheimer* at [0045]-[0046]. Accordingly, *Oppenheimer* clearly fails to teach or suggest a method wherein a server completes the document-inclusion instruction *only if the unavailable document is sent to the server by the client.*

For at least the foregoing reasons, Applicants respectfully submit that *Anderson, Oppenheimer,* and *LaRue,* alone and in combination, if they can even be combined, do not teach or suggest what is recited by the claims of the present application.

Although the foregoing remarks have been focused primarily on the independent claims, it will be appreciated that all of the rejections and assertions of record with respect to the

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independent claims, as well as the dependent claims, are now moot, and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicant does not necessarily acquiesce to any assertions in the previous Office Action that are not specifically addressed above, and hereby reserves the right to challenge those assertions at any appropriate time in the future, should it arise, including any official notice.

In the event of any further question that may be clarified by a teleconference, the Examiner is invited to initiate the same with the undersigned attorney of record.

Dated this 21 day of October, 2005.

Respectfully submitted,
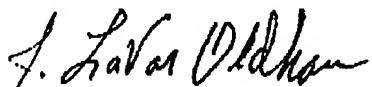
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